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**PATENT APPLICATION**

Reinhart Boerner Van Deuren S.C.

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Date: May 14, 2007

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

GROUP ART UNIT: 3727

EXAMINER: JES F. PASCUA

In re application of: Aaron Strand,	)	
Karl L. Linck, Judy Fischer,	)	
Thomas Spaeth, and Jerry D. Kolbe	)	
	)	
Application No: 09/774,275	)	
	)	
Confirmation No.: 2989	)	For: A RESEALABLE BAG FOR
	)	FILLING WITH FOOD
Filed: January 30, 2001	)	PRODUCT(S) AND METHOD
	)	
Attorney Docket No. 8362-CIP-	)	
DIV	)	
	)	
Customer No.: 22922	)	

Commissioner for Patents  
MAIL STOP APPEAL BRIEF - PATENTS  
P.O. Box 1450  
Alexandria, VA 22313-1450

May 14, 2007

SUPPLEMENTAL REPLY BRIEF

Sir:

Appellants, in response to the Supplemental Examiner's Answer mailed March 15, 2007, and pursuant to 37 C.F.R. § 41.41, hereby file this Supplemental Reply Brief as part of the appeal on the above-referenced patent application.

**Reply to the Supplemental Examiner's Answer -- Introduction**

While much of the Supplemental Examiner's Answer is a word-for-word repetition of the April 22, 2005, Office Action, the Examiner has added some new arguments which were not focused upon in the April 22, 2005, Office Action. These arguments can be divided up into four sections: 1. very brief comments on the Examiner's mention of the Section 112, first paragraph, rejection; 2. very brief comments regarding the Examiner's use of official notice; 3. arguments regarding what is fairly taught by the Plourde '611 reference and how the mischaracterization of the Plourde '611 reference has been improperly used by the Examiner to justify the Section 103(a) combination rejections; and 4. arguments regarding the circumstances under which references may be combined in a rejection for which arguments are asserted by the Examiner to be based upon case law, but which arguments in fact are conclusory and are based upon hindsight, unsupported by the facts, and fail to make the findings explicitly required by the cited case law. These arguments will be addressed in the order mentioned above.

**Observations and Arguments**

**I.     The Section 112, First Paragraph, Rejection.** The Examiner's Section 112, first paragraph, rejection of Claims 86 and 106 was and is erroneous. Appellants are required to teach one skilled in the art how to practice the invention as claimed. The areas of structural weakness which extend nonlinearly across a width dimension or a length dimension are in fact clearly shown in Fig. 5 (which is attached hereto as an Evidence Appendix), and are described in the accompanying portion of the specification: "This embodiment includes score lines 12 laid out in an alternative pattern that includes curve or arcuate section 13. . . ." Thus, the score lines 12 are nonlinear in that they include the curve or arcuate sections 13 at each end thereof. One skilled in the art will readily and completely understand the subject matter of the these claims, and, as such, the rejection of Claims 86 and 106, and of Claims 87, 88, 107, and 108, which are dependent thereupon, is incorrect.

**II.    The Examiner's Use of Official Notice.** The Examiner's use of "official notice" as referred to in the last sentence of page 5 is alleged by the Examiner to relate to an admission of prior art by Appellants. This is simply incorrect, and the use of official notice by the Examiner is in fact little more than an explicit admission by the Examiner that he was unable to find a reference teaching part of Appellants' claims in the prior art. Instead of allowing the claims as is required by the law, the Examiner instead relied upon

an incorrect assertion that is clearly in violation of proper procedure. "It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. ... It is never appropriate to rely solely on 'common knowledge' in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. In Re Zurko, 258 F.3d at 1385, 59 USPQ2d at 1697 ('[T]he Board cannot simply reach conclusions based on its own understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.')." MPEP Section 2144.03.

**III. The Examiner's Mischaracterization of the Plourde '611 Reference is an Erroneous Basis for Making Section 103(a) Combination Rejections.** The Examiner bases the Section 103(a) combination rejections upon his assertion that the use of "the areas of structural weakness of Plourde '611, in order to provide a wider access to the interior of the bag" (page 4, lines 9-10) justifies combining the Plourde '611 reference with the Lingenfelter reference. In arguing this point, the Examiner states:

"[t]he difference in the width of the opening would be measured by the amount of bag material removed between the two lines of perforations 40, shown in cross-section in Fig. 4 of Plourde, as compared to no bag material

removed by the single line of perforations as shown in Lingenfelter." Page 8, lines 17-20.

The Examiner has chosen to ignore a basic geometric fact (and not Appellants' opinion as erroneously asserted by the Examiner) that determines the maximum opening of any bag made of flexible material -- the maximum size of the opening in a bag made of flexible material is related only to the length of the opening and the flexibility of the outer side walls of the bag, and is not (and indeed cannot be) related to the size of flaps which comprise part of an inner seal contained in the bag. The single tearline 32 in the Lingenfelter reference does not remove any material of the panels 19 and 21, but that is irrelevant since the panels 19 and 21 of the Lingenfelter reference are secured to the side walls of the bag 10. It is the length of the opening in the Lingenfelter bag 10 and the flexibility of the side walls of that bag 10 that determine the size of the opening in the Lingenfelter bag 10. Using an arc of material with two perforations 40 between the sides as an inner seal in the Plourde '611 bag 50 and removing the portion of the arc of material between the two perforations 40 does not (and indeed can not) increase the size of the opening in the Plourde '611 bag 50. The size of the opening in the Plourde '611 bag 50 is still limited by the length of the opening in the Plourde '611 bag 50 and the flexibility of the Plourde '611 bag 50.

The Examiner's bare assertion that he disagrees with Appellants' position does not make a basic geometric fact untrue. The use of the dual perforations 40 of the Plourde

'611 reference in the Lingenfelter bag 10 would not and indeed could not increase the size of the opening in the Lingenfelter bag 10. In fact, the Plourde '611 construction would not be used by one skilled in the art to increase the size of the opening in the Lingenfelter bag 10 -- rather it would be avoided since it could make the size of the opening in the Lingenfelter bag 10 smaller rather than larger. In the Plourde '611 bag 50, after the material between the perforations 40 is removed (as shown in Fig. 4), the remaining portions of the sheet material 10 will likely flop toward each other, thereby actually narrowing the width of the opening. Since the panels 19 and 21 of the Lingenfelter bag 10 are attached to the sides of the Lingenfelter bag 10, they could not flop toward each other after the tearline 32 is torn. Accordingly, the Examiner's reason justifying the combination is clearly incorrect as a matter of basic geometry.

This is the only reason given either in the April 22, 2005, Office Action or in the Supplemental Examiner's Answer to justify the combination. Since this reason is clearly incorrect, the combination of references is also incorrect. No one skilled in the art would use the Plourde '611 reference's construction with the Lingenfelter reference's device since the resulting combination has no benefit and quite possibly has a significant detriment. The combination of the Plourde '611 reference's with the Lingenfelter reference is thus incorrect, and the rejections of the claims must be overturned on this basis.

Further, the Examiner has misrepresented the relevance of In re Keller, which case in point of fact is not helpful to the Examiner's case. As stated in a more recent Federal Circuit case that cited In re Keller, "[t]he test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (and cases cited therein). In re Werner Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). Since one skilled in the art would have no reason to combine the Plourde '611 reference with the Lingenfelter reference, Appellants submits that the Section 103(a) rejections must fall, and respectfully solicits the removal of the Section 103(a) rejections of independent Claims 75, 96, 116, and 138, and the allowance of these claims as well as the claims depending therefrom.

**IV. The Examiner's Arguments Regarding Combinations of References.** In the Supplemental Examiner's Answer, the Examiner asserted that case law including particularly In re McLaughlin, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971) (from which the Examiner recites that "any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. . .") somehow justified the Examiner's clear use of impermissible hindsight in taking the elements of Appellants' claims and using them as a laundry list of constituents which the Examiner asserted (incorrectly) are

found in two separate and unrelated references. The Supplemental Examiner's Answer continues, stating that "the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)."

In the April 22, 2005, Office Action the only reason identified for making the combination -- to provide a wider access opening to the interior of the bag -- has been established to be clearly incorrect as a matter of basic geometry (See Section III above). What is clear is that the Examiner did not even attempt to ascertain the knowledge generally available to one of ordinary skill in the art. It is telling that in both In re Fine and In re Jones, cases referenced in the Supplemental Examiner's Answer, rejections of the claims were reversed for doing exactly what the Examiner has done in the April 22, 2005, Office Action -- failing to make an explicit analysis as to the reason to combine cited references.

Recently, the Supreme Court weighed in on the issue of obviousness and noted that the analysis supporting a rejection under 35 U.S.C. Section 103(a) should be made explicit, and that it was "important to identify a reason that would have prompted a

person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. The Court specifically stated:

"Often, it will be necessary . . . to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an **apparent reason** to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis **should be made explicit.**"

*KSR Int'l. Co. v. Teleflex, Inc.* Slip Opinion 04-1350 (2007), emphasis added.

Therefore, in formulating a rejection under 35 U.S.C. Section 103(a) based upon a combination of prior art elements, even after *KSR* it remains necessary to explicitly identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed. Notably, the only such finding justifying the combination in the April 22, 2005, Office Action has been established to be clearly incorrect as a matter of basic geometry (See Section III above). Appellants maintain that one of ordinary skill in the art would not make such a geometric mistake, and hence would never arrive at the claimed combination. Since a proper and logically valid analysis has clearly not been performed, Appellants respectfully solicits the removal of

the Section 103(a) rejections of Claims 75, 96, 116, and 138, and the allowance of these claims as well as the claims depending therefrom.

### **Conclusions**

1. The Supplemental Examiner's Answer continued to mischaracterize the Plourde '611 reference, which fails to teach increasing the size of the opening in the Lingenfelter reference, and since the Section 103(a) rejection relies upon the Plourde '611 reference for this teaching as the basis upon which to combine the references, the rejection is accordingly deficient.
2. The Supplemental Examiner's Answer failed to meet the well-established and clear requirements for combining references under Section 103(a), and the combinations of references made in the Section 103(a) rejections are based entirely on the impermissible use of hindsight, with the Examiner's knowledge of Appellants' claims and the use of that knowledge having provided a list of elements and limitations to search for in otherwise unrelated references.
3. The Supplemental Examiner's Answer failed to respond to the arguments in Appellants' March 24, 2006, Appeal Brief that each of independent Claims 75, 96, 116, and 138 includes multiple limitations which are not taught or suggested by any of the cited prior art references, either individually or in combination. Therefore, that argument stands as uncontroverted.

Accordingly, Appellants believe that the independent claims of the present application are drafted in a manner which clearly defines them over the prior art. As such, all of the dependant claims are believed to be patentable as well. Appellants believe that the invention as presently claimed is novel and nonobvious over the cited art as well as all other art of which Appellants are presently aware. Appellants accordingly respectfully request the removal of all rejections of pending Claims 75-116 and 138-153, and the allowance of the present application in its entirety.

Respectfully submitted:

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**Evidence Appendix**